

REMARKS

Claims 7-11, 14, 15 and 20-26 are all the claims pending in the application, of which claims 7, 14, 15 and 21 are independent. Claims 7, 14, 15, 20 and 21 are being amended.

I. Claim Amendments

The Applicant herein amends independent claims 7, 14, 15 and 21 to further describe the method step of “transmitting data representative of the at least one user’s usage to the first user by way of a monitor window when the user is connected to any other website on the communication network, such that the user can simultaneously view the data representative of the usage and any other website.” (added subject matter underlined).

Support for the amendment can be found in the Specification from page 46, line 20 to page 47, line 22.

The Applicant also amends claim 20 to correct a minor grammatical error.

II. Claim Rejections: 35 USC §103(a)

The Examiner rejected claims 7-11, 14, 15 and 20-26 under 35 USC §103(a) as allegedly being unpatentable over Hoyer et al., US Pat. No. 6,381,635 (hereinafter “Hoyer”) in view of Smith et al., US Pat. No. 6,578,078 (hereinafter “Smith”).

a. Rejection Moot in View of Claim Amendment

The Applicant submits, in lieu of the newly amended claims, that the rejection under 35 USC §103(a) is moot. Specifically, neither Hoyer or Smith, taken alone or in combination, teach where *the user can simultaneously view the data representative of the usage and any other website*, as recited in the amended claims. The Examiner admits that “Hoyer does not

specifically disclose transferring data to user when user connected to other websites,” (*Office Action*, June 13, 2005, p. 3) and therefore Hoyer also cannot teach where a user can simultaneously view the data representative of the usage and any other website.

Smith also fails to teach the elements of the newly amended claims, as Smith is limited to simply transferring data to a user when a user requests data for a new website from a server. *Smith*, col. 11, lines 57-61. Smith does not teach simultaneous viewing of data and another website, and in fact teaches the opposite, as data transmitted in Smith is related to a new webpage that the user requests by clicking on a hyperlink. *Smith*, col. 11, lines 57-61 and Abstract. The user in Smith is then displayed the new data from the new webpage instead of the old webpage.

Smith therefore fails to teach, suggest or provide any motivation for the claimed invention, including the ability of the user to simultaneously view the data representative of the usage and any other website. Therefore, the Applicant requests that the rejection of claims 7, 14, 15 and 21 under 35 USC §103(a) be withdrawn. The Applicant also submits that claims 8-11, 20 and 22-26 are also allowable at least based on their dependencies to claims 7 and 21.

b. No Apparent Reason to Combine Hoyer and Smith

The Applicant also submits that the Examiner has failed to state a prima facie case of obviousness under 35 USC §103(a), as the Examiner has failed to provide an apparent reason to combine the elements of Hoyer and Smith, including any express articulation of the underlying analysis supporting an apparent reason to combine these elements. *KSR Intl. Co. v. Teleflex, Inc., et al.*, 550 US ____ (2007), *Opinion* at p. 4.

In the Final Office Action dated June 13, 2005, the Examiner states that “Smith *in the same usage monitoring environment* discloses transferring data to [sic] user when [sic] user [sic] connected to other web sites...” *Office Action*, June 13, 2005, p. 3 (emphasis added).

The Applicant first points out, with regard to the emphasized statement, that the invention of Smith has nothing to do with a “usage monitoring environment.” Smith is directed to preserving the integrity of references within websites, as noted in the Abstract, which states that “the integrity of uniform resource locators (URL) references within web sites are maintained when changes occur in the locations where resources referenced by URLs are stored.” *Smith*, Abstract. There is nothing related to usage monitoring in the primary invention of Smith. To accomplish the inventive purpose, Smith uses a Referential Preservation Engine (RPE) to maintain a database of the location of web site documents and update the hyperlinks to these web site documents if the location of the documents is moved. *Smith*, Abstract. Again, the Applicant points out that Smith is directed to maintaining URL references, not monitoring usage of a user.

The Examiner later argued that “both references point to the same network environment,” because Smith “points to a method for tracking user’s favorite sites and document stored in an [sic] internet browser in a web server communications.” *Examiner’s Reply Brief*, October 30, 2007, p. 12. Smith briefly mentions that one feature of updating the hyperlinks is that “The RPE also can track usage of a user’s favorite sites and/or documents that are stored in an Internet browser and update the URL references for these favorites when the resources they are mapped to are moved (or renamed).” *Smith*, Abstract. However, this briefly discussed feature is wholly unrelated to the general invention of Smith: that of preserving the integrity of references within websites.

The Applicant disagrees that the unrelated discussion of tracking in Smith would deem Smith to be considered “in the same usage monitoring environment” as the invention claimed herein. Furthermore, the minor reference to tracking in Smith is also completely unrelated to the teaching of Smith cited by the Examiner to combine with Hoyer, that of “transferring data to [a] user when [a] user [is] connected to other websites.” The disclosure in Smith of transferring data to a user when a user is connected to another website has nothing to do with the usage tracking feature mentioned in Smith. Instead, the section of Smith cited by the Examiner has to do with a user viewing a website with a hyperlink selecting the hyperlink and receiving data related to the webpage associated with that hyperlink. The Applicant submits that no person of ordinary skill in the art would be motivated to combine the data transfer teachings of Smith with the user tracking features of Hoyer to arrive at the invention of the present claims, as Smith in general, and specifically the teaching cited by the Examiner, is wholly unrelated to usage tracking.

The Applicant notes that it is legally insufficient to conclude that a claim is obvious merely because each feature of the claim is independently shown in the cited art. *KSR*, Opinion at p. 14. The Applicant submits that the combination of Smith and Hoyer are not a “predictable use of prior art elements according to their established functions,” as the teaching cited by the Examiner in Smith is wholly unrelated to a usage monitoring feature, and the two references otherwise provide no motivation to combine their teachings that would result in the invention of the present claims. *KSR*, Opinion at p. 13.

c. No Sufficient Rationale for the Asserted Combination

The Applicant additionally submits that the Examiner has failed to state a prima facie case of obviousness under 35 USC §103(a), as the Examiner has not provided “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”

KSR, Opinion at p. 14. Furthermore, the Examiner has not provided “a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *KSR*, Opinion at p. 15.

The Examiner states that it would have been obvious to one of the ordinary skill in the art at the time the invention was made “to incorporate Smith’s teachings into the computer system of Hoyer to process data information in the [sic] internet *because it would have enabled users to easily retrieve web pages and resource information from web servers at a desired location in a communications network.*” *Office Action*, June 13, 2005, p. 3-4 (emphasis added). However, Examiner’s stated reason to combine Hoyer and Smith is completely unrelated to the benefit of the invention of the present claims. Easily retrieving web pages and resource information from web servers at a desired location in a communications network is not a purpose of the invention of the present claims. The claimed invention is directed to providing usage information on a web site to a user—not easily retrieving web pages or resource information. The Examiner does not elaborate on the meaning of “resource information” or why it would the activities are performed “at a desired location in a communications network.” Neither does the Examiner elaborate on the broad statement of apparent motivation such that the Applicant is able to understand what the articulated reasoning should be. The Examiner cites to Smith for the teaching of transferring data to a user when the user is connected to another web site, but the Examiner’s conclusion as to why to combine Hoyer and Smith does not specify how this teaching provides motivation to arrive at the claimed invention.

Therefore, the Applicant submits that the Examiner’s statement of motivation does not amount to an articulated reasoning with any rational underpinning supporting the legal

conclusion of obviousness, as required for a prima facie case of obviousness under 35 USC §103(a).

For at least the reasons stated above, the Applicant requests that the rejection of claims 7, 14, 15 and 21 under 35 USC §103(a) be withdrawn. The Applicant also submits that claims 8-11, 20 and 22-26 are also allowable at least based on their dependencies to claims 7 and 21.

III. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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